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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,608	02/26/2002	Edward G. Tiedemann JR.	020277	7078

23696 7590 08/11/2004

Qualcomm Incorporated
Patents Department
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EXAMINER

TSEGAYE, SABA

ART UNIT PAPER NUMBER

2662

7

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,608

Applicant(s)

TIEDEMANN ET AL.

Examiner

Saba Tsegaye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4, 6.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 3 is objected to because of the following informalities: On line 3, the "period" after the word "comprises" should be replaced by a "colon".

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1: line 5, the phrase "the modified message" lacks antecedent basis.

Claim 7: line 4, it is not clear whether "a first system access frequency" is refer to a first system access frequency cited in claim 6, line 4.

Claim 11, line 3, the phrase "the subscriber station...with an IS-95 standard" lacks antecedent basis.

Claims 12 and 13, in line 2, the phrase "said assigning a first frequency on which a first synchronization" lacks antecedent basis.

Claim 14, line 6, the phrase "the modified message" lacks antecedent basis.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Czaja et al. (US 6,567,666).

Czaja discloses a method for forward link inter-generation soft handoff between second generation and third generation CDMA system. Further, Czaja discloses modulating a message on a first synchronization channel transmitted on at least one first frequency from at least one sector (column 4, lines 53-67; column 8, lines 57-60); and modulating a modified message on a second synchronization channel transmitted on at least one second frequency from the at least one sector (column 5, lines 1-6; column 8 lines 61-64).

Regarding claim 2, Czaja discloses the method wherein the modulating a message on a first synchronization channel transmitted on at least one first frequency from the at least one sector comprises: modulating a Sync channel Message on a first synchronization channel transmitted on at least one first frequency from the at least one sector (column 7, lines 33-38).

Regarding claim 3, Czaja discloses the method wherein the modulating a modified message on a second synchronization channel transmitted on at least one second frequency from the at least one sector comprises: modulating the modified Sync Channel Message on a second

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synchronization channel transmitted on at least one second frequency from the at least one sector (column 7, lines 33-38).

Regarding claim 4, Czaja discloses the method wherein the modulating the modified message on a second synchronization channel transmitted on at least one second frequency from the at least one sector comprises: deleting at least one field from at message (column 7, lines 15-32).

6. Claims 5-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Park et al. (US 6,741,868).

Regarding claim 5, Park discloses a method for assigning a system access frequency to a subscriber station in a communication system operating in accordance with at least two standards, comprising:

determining a standard in accordance with which the subscriber station is capable of operation (column 18, lines 19-41); and

assigning a system access frequency to the subscriber station in accordance with the determination (column 18, lines 19-44).

Regarding claim 6, Park discloses the method wherein the assigning a system access frequency to the subscriber station in accordance with the determination comprises:

assigning a first system access frequency to the subscriber station operating in accordance with a first standard (column 18, lines 39-44; column 19, line 60-column 20, line 3); and

assigning a second system access frequency to the subscriber station operating in

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accordance with a second standard (column 18, lines 45-55; column 19, line 60-column 20, line 3).

Regarding claim 7, Park discloses the method wherein the assigning a first system access frequency to the subscriber station operating in accordance with a first standard comprises:

assigning a first system access frequency to the subscriber station operating in accordance with an IS-2000 standard (column 1, lines 60-65).

Regarding claims 8, Park discloses the method wherein the assigning a first system access frequency to the subscriber station operating in accordance with an IS-2000 standard comprises:

assigning a first frequency on which a first synchronization channel modulated by a message is transmitted (column 19, lines 12-36).

Regarding claim 9, Park discloses the method wherein the assigning a first frequency on which a first synchronization channel modulated by a message is transmitted comprises:

assigning a first frequency on which a first synchronization channel modulated by a sync channel message is transmitted (column 19, lines 12-36).

Regarding claim 10, Park discloses the method wherein the assigning a second system access frequency to the subscriber station operating in accordance with a second standard

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comprises:

assigning a second system access frequency to the subscriber station operating in accordance with an IS-95 standard (column 19, line 66-column 20, line 11; column 19, lines 45-59).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Czaja et al. in view of Park et al.

Regarding claim 14, Czaja discloses all the claim limitations as stated above, except for assigning the first frequency as a system access frequency to a subscriber station operating in accordance with a first and assigning the second frequency as a system access frequency to a subscriber station operating in accordance with a second standard.

Park teaches that a hybrid type BTS/BSC determines the operating type of the core network and sends the determined core network operating type to a terminal.

It would have been obvious to one ordinary skill in the art at the time the invention was made to use the teaching of Park of subscriber station is assigned a primary frequency in

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accordance with a standard with which the subscriber station is capable of operating to a CDMA cellular radiotelephone system of Czaja. One ordinary skill in the art would have been motivated to do this because assigning a primary frequency in accordance with a standard provides a smooth service transition when a subscriber travels from one service area to another service area.

Regarding claim 15, Czaja discloses the method wherein the modulating the modified message on a second synchronization channel transmitted on at least one second frequency from the at least one sector comprises: deleting at least one field from at message (column 7, lines 15-32).

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kransmo discloses a method a node for providing handover and roaming of wireless terminal from a 3G communication system to a 2G communication system.

DeClerck et al. (US 6,198,937) a method and apparatus for controlling radio link capacity in a communication system.

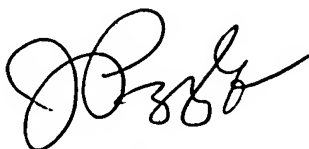
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saba Tsegaye whose telephone number is (571) 272-3091. The examiner can normally be reached on Monday-Friday (7:30-5:00), First Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ST
August 7, 2004



JOHN PEZZLO
PRIMARY EXAMINER